



Docket No.: M062
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael J. Sundermeyer et al.

Application No.: 10/690,214

Confirmation No.: 2346

Filed: October 21, 2003

Art Unit: 2176

For: WEB SITE MANAGEMENT LIFECYCLE

Examiner: M. K. Botts

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AFTER FINAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant requests review of the final rejection in the above-identified application. No amendments are being submitted with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated below.

REASONS FOR REQUESTED PRE-APPEAL REVIEW

I. Issues

Claims 1-31 are pending in the present application. Claims 1-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by GlobalScape, "CuteFTP Pro Technical Overview," White Paper, May 22, 2001 (hereinafter *CuteFTP*). Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Altova Inc. & Altova GmbH, "XML Spy 4.0 Manual," September 10, 2001 (hereinafter *XML Spy*). Claims 21-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *XML Spy* in view of *CuteFTP*. Appellant respectfully submits that the outstanding rejections are improper at least for the reasons set forth in Appellant's Response to Non-Final Office Action of June 14, 2006, and particularly in light of the remarks presented herein.

II. Rejections under 35 U.S.C. § 102 over *CuteFTP*

Claims 1-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by *CuteFTP*. It is well settled that, in order to anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.

Claims 1 and 11 require, in part, “browsing to a Web page to be edited” *The Examiner has not yet addressed this limitation.* See Final Office Action, pages 3 and 19. Appellant points out that *CuteFTP* only discloses an FTP client, and that merely transferring a file to or from a server via an FTP client, even if that file is an HTML file, is not the same as “browsing to a Web page.” See *CuteFTP*, page 12.

Claims 1 and 11 also require, in part, “automatically downloading a source file for said Web page from a file transfer server related to said Web page including related files associated with display of said Web page.” Appellant has acknowledged that *CuteFTP* discloses automatically downloading or uploading log files. *CuteFTP*, page 7. However, *CuteFTP*’s log file is not “a source file for a Web page [that has been browsed to]” See *id.* Thus, *CuteFTP* does not teach or suggest “automatically downloading a source file for said Web page [that has been browsed to] . . . ,” much less “automatically downloading related files associated with display of said Web page,” as required by claim 1 and 11. Appellant asserts that the Examiner’s attempt to rebut these arguments is non-responsive. See Final Office Action, page 19. Particularly, Appellant has not argued that claims 1 and 11 require a log file, but that *CuteFTP*’s log file does not meet the claimed source file.

Claims 1 and 11 further require, in part, “automatically publishing said edited source file to said file transfer server associated with said Web site including said related files associated with said display of said Web page.” The Examiner relies upon *CuteFTP* as teaching or suggesting the periodic updating of a web site. Final Office Action, page 3. However, as noted above, *CuteFTP* does not teach or suggest that the file to be periodically uploaded is a source file for a Web page that has been browsed to. In addition, *CuteFTP* does not teach or suggest automatically publishing related files associated with display of the Web page, as required by claims 1 and 11. Again, the Examiner’s attempt to rebut these arguments is non-responsive. See Final Office Action, page 19. Appellant has not argued that claims 1 and 11 require that a file be periodically uploaded. Instead, Appellant has

asserted that *CuteFTP*'s periodic uploading does not meet the claimed publishing because *CuteFTP*'s file to be periodically uploaded is neither a source file nor a file associated with display of a Web page browsed to.

Dependent claims 2-10 and 12-19 depend, either directly or indirectly from claims 1 or 11, respectively, thus inheriting all the limitations of their respective independent claims. As noted above, *CuteFTP* does not teach every element of independent claims 1 and 11. Thus, *CuteFTP* also fails to teach each and every element of dependent claims 2-10 and 12-19. Accordingly, Appellant respectfully requests that the Examiner withdraw the Review Panel reverse 35 U.S.C. § 102(b) rejections of record with respect to claims 1-19.

III. Rejections under 35 U.S.C. § 103 over *XML Spy*

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *XML Spy*. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. M.P.E.P. § 2143. Without conceding the second criterion, Appellant asserts that the Examiner's rejection of these claims does not satisfy the first and third criteria.

A. Lack of Motivation

The Examiner states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have used the function of XML Spy to monitor documents on a server, and to edit documents within a browser for a browser, to have used a browser to locate a Web page to be edited, for the obvious reason and beneficial purpose that XML Spy is obviously designed to cooperate with and use browsers in accessing and editing documents located on the Web." Final Office Action, page 12. Even assuming, *arguendo*, that *XML Spy* is "designed to cooperate with and use browsers," the Examiner has not shown why it would be desirable to modify *XML Spy*. Appellant respectfully points out that the Examiner's proposed motivation is only a statement that the *XML Spy can be* modified. However, the mere fact that a reference *can be* modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01.

There is no suggestion or motivation, either in the prior art or in the knowledge available to a person of ordinary skill in the art, to modify *XML Spy*.

B. Lack of All Claimed Limitations

Appellant respectfully points out that the Examiner has not specifically addressed many of the limitations required by claim 20, and ***omnibus rejections do not conform with Office policy***. See M.P.E.P. § 707.07(d). Moreover, Appellant asserts that several of the limitations required by claim 20 are not taught or suggested by the prior art of record. For example, claim 20 requires, in part, “displaying a Web browser in a first window of said GUI, wherein a user browses on said Web browser to locate a Web page to be edited.” Appellant points out that *XML Spy* only discloses an XML development environment. *XML Spy*, pages 92-96. As such, the “page window editor” referred to by the Examiner is an XML editor, not a Web browser. *Id.* Accordingly, Appellant respectfully requests that the Examiner withdraw the Review Panel reverse 35 U.S.C. § 103(a) rejections of record with respect to claim 20.

IV. **Rejections under 35 U.S.C. § 103 over *XML Spy* in view of *CuteFTP***

Claims 21-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *XML Spy* in view of *CuteFTP*.

A. Lack of Motivation

The Examiner states that “[t]he motivation to combine [*CuteFTP* with *XML Spy*] is taught in *CuteFTP* in that it is designed to upload web compatible software to the web[,] and web compatible software is taught to be created using *XML Spy*.” Final Office Action, page 23. Appellant respectfully points out that the Examiner’s proposed motivation is only a statement that the references ***can be*** combined. However, the mere fact that references ***can be*** combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01. There is no suggestion or motivation, either in the prior art or in the knowledge available to a person of ordinary skill in the art, to combine an FTP client with an XML editor. In fact, the combination of such disparate teachings is simply nonsensical.

B. Lack of All Claimed Limitations

Claim 21 recites, in part, “a Web browser displayed to said user in a main window of said GI” The Examiner relies solely upon *XML Spy* as meeting this limitation. Final Office Action, page 13. As previously noted, neither *XML Spy* nor *CuteFTP* teach or suggest a Web browser. *XML Spy*, page 92; *CuteFTP*, page 12. Therefore, the combination of *XML Spy* with *CuteFTP* does not teach or suggest a Web browser. The Examiner’s attempt to rebut this argument is non-responsive insofar as it does not identify any portion of *XML Spy* or *CuteFTP* that teaches or suggests a Web browser. Final Office Action, page 22.

Dependent claims 22-31 depend, either directly or indirectly from claim 20, thus inheriting all the limitations of that independent claim. As noted above, the combination of *XML Spy* with *CuteFTP* does not teach or suggest every element of independent claim 20. Thus, the combination of *XML Spy* with *CuteFTP*, even if proper, also fails to teach or suggest each and every element of dependent claims 21-31. Accordingly, Appellant respectfully requests that the Examiner withdraw the Review Panel reverse 35 U.S.C. § 103(a) rejections of record with respect to claims 21-31.

V. Summary

In view of the above, Appellant respectfully requests that the Review Panel reverse the outstanding rejections. The required fee for the Notice of Appeal filed with this request is attached. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 47583-P042US-10311288 from which the undersigned is authorized to draw.

Dated: December 5, 2006

Respectfully submitted,

By 

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